



UNITED STATES PATENT AND TRADEMARK OFFICE

en

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|--------------------------|---------------------|------------------|
| 10/788,902 | 02/26/2004 | Christopher W. Blackburn | 1842.022US1 | 4532 |

21186 7590 11/21/2006

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. BOX 2938
MINNEAPOLIS, MN 55402

EXAMINER

LEUNG, JENNIFER

ART UNIT PAPER NUMBER

3709

DATE MAILED: 11/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/788,902

Applicant(s)

BLACKBURN ET AL.

Examiner

Jennifer Leung

Art Unit

3709

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 7/6/2004 and 7/29/2005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "322" and "324" have both been used to designate "service description". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The disclosure is objected to because of the following informalities:

Page 1, line 8: -- 10/788,903 -- should be inserted after "serial no."

Page 3, line 24: "for a providing" should be -- for providing --.

Page 7, line 11: "16" should be -- 216 --.

Art Unit: 3709

Page 11, lines 22 and 24: "service descriptions" has different numbers for the same part.

Appropriate correction is required.

Claim Objections

3. Claims 3, 12, 15, 22 and 31 are objected to because of the following informalities:

Claim 3, lines 1-2: insert "by the gaming machine" after "comprises a request".

Claim 12, line 2: "updated." should be -- updated; and --.

Claim 15, line 2: "for game content update" should be -- for a game content update --.

Claim 15, line 2: insert "by the gaming machine" after "request".

Claim 22, line 2: insert "by the gaming machine" after "request".

Claim 31, line 2: "that game content" should be -- that the game content --.

Claim 31, line 2: "updated." should be -- updated; and --.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Art Unit: 3709

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 and 20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1 and 20 do not produce a useful, concrete, and tangible result. Publishing the availability of a service does not require any transformation.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Unlike claims 3, 11, 22, and 30, claim 15 requests only an update, not a notification of the update. Because claim 15 only requests a game content update, it is similar to claim 17, which also requests a download of the game content.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Gatto (US 6,916,247).

Re claim 1: Gatto discloses a method for providing a game update service in a gaming network (col. 15, lines 20-30), the method comprising: publishing the availability of the game update service on the gaming network (Fig. 19; col. 13, lines 64-67); receiving a request to register with the game update service from a gaming machine (Fig. 20); and processing one or more service requests between the gaming machine and the game update service (Fig. 19; col. 15, lines 45-49; col. 15, lines 57-60; col. 16, lines 7-11; col. 18, lines 4-6).

Re claim 2: Gatto further discloses the method of claim 1, wherein the game update service comprises a web service (col. 15, lines 49-56).

Art Unit: 3709

Re claim 3: Gatto further discloses the method of claim 1, wherein the service request comprises a request for notification of a game content update by the gaming machine (Fig. 20; col. 5, lines 1-2; col. 14, lines 10-32).

Re claim 4: Gatto further discloses the method of claim 3, further comprising: receiving a game content change (col. 17, lines 10-12; col. 19, lines 55-58); and issuing a notification of the game content update to the gaming machine in response to the game content change (Fig. 20; col. 5, lines 1-2; col. 14, lines 10-32).

Re claim 5: Gatto further discloses the method of claim 1, wherein the service request comprises a request to download game content to the gaming machine (col. 15, lines 20-30).

Re claim 6: Gatto further discloses the method of claim 5, wherein the service request is initiated by the gaming machine (col. 16, lines 1-3; col. 20, lines 32-37; col. 16, lines 7-11: if the gaming machine can function as either the service requestor or provider, then the request can be initiated by the gaming machine).

Re claim 7: Gatto further discloses the method of claim 5, wherein the service request is initiated by the game update service (col. 16, lines 1-3; col. 20, lines 32-37; col. 16, lines 7-11: if the service can function as either the service requestor or provider, then the request can be initiated by the service; as described in the specification of the current

Art Unit: 3709

application (10/788902), this is the PUSH method (page 17, lines 26-28). The applicant admits that this method is prior art (page 20, lines 9-11)).

Re claim 8: Gatto discloses a method for updating game content on a gaming machine via a game update service in a gaming network (col. 15, lines 20-30), the method comprising: issuing a request to discover a service description for the game update service (col. 15, lines 60-62); receiving the service description (col. 15, lines 63-67); registering with the game update service (Fig. 20; col. 15, lines 62-63; col. 17, lines 22-24); and processing one or more service requests between the gaming machine and the game update service (Fig. 19; col. 15, lines 45-49; col. 15, lines 57-60; col. 16, lines 7-11; col. 18, lines 4-6).

Re claim 9: Gatto further discloses the method of claim 8, wherein the game update service comprises a web service (col. 15, lines 49-56).

Re claim 10: Gatto further discloses the method of claim 9, wherein the service description comprises a web services description language (col. 15, lines 52-53).

Re claim 11: Gatto further discloses the method of claim 8, wherein the service request comprises a request for notification of a game content update (Fig. 20; col. 5, lines 1-2; col. 14, lines 10-32).

Art Unit: 3709

Re claim 12: Gatto further discloses the method of claim 11, further comprising: receiving a notification that game content has been updated (Fig. 20; col. 5, lines 1-2; col. 14, lines 10-32); and issuing a request to download the game content (col. 15, lines 20-30).

Re claim 13: Gatto discloses a gaming network system providing a game update service (col. 15, lines 20-30), the gaming network system comprising: a game update service communicably coupled to a gaming network (Fig. 19; col. 13, lines 64-67); a discovery agent communicably coupled to the gaming network (Fig. 19; col. 15, lines 49-56; col. 15, lines 63-67; col. 16, lines 14-19); and at least one gaming machine communicably coupled to the gaming network (Fig. 1; col. 5, lines 29-32); wherein the game update service is operable to: publish the availability of the game update service to the discovery agent (Fig. 19; col. 13, lines 64-67; col. 15, lines 54-56); receive registration requests from the at least one gaming machine (Fig. 20); and process service requests between the gaming machine and the game update service (Fig. 19; col. 15, lines 45-49; col. 15, lines 57-60; col. 16, lines 7-11; col. 18, lines 4-6).

Re claim 14: Gatto further discloses the gaming network system of claim 13, wherein the game update service comprises a web service (col. 15, lines 49-56).

Art Unit: 3709

Re claim 15, as understood: Gatto further discloses the gaming network system of claim 13, wherein the service request comprises a request for notification of a game content update by the gaming machine (Fig. 20; col. 5, lines 1-2; col. 14, lines 10-32).

Re claim 16: Gatto further discloses the gaming network system of claim 13, wherein the game update service is further operable to: receive a game content change (col. 17, lines 10-12; col. 19, lines 55-58); and issue a notification of the game content update to the gaming machine in response to the game content change (Fig. 20; col. 5, lines 1-2; col. 14, lines 10-32).

Re claim 17: Gatto further discloses the gaming network system of claim 13, wherein the service request comprises a request to download game content to the gaming machine (col. 15, lines 20-30).

Re claim 18: Gatto further discloses the gaming network system of claim 17, wherein the service request is initiated by the gaming machine (col. 16, lines 1-3; col. 20, lines 32-37; col. 16, lines 7-11: if the gaming machine can function as either the service requestor or provider, then the request can be initiated by the gaming machine).

Re claim 19: Gatto further discloses the gaming network system of claim 17, wherein the service request is initiated by the game update service (col. 16, lines 1-3; col. 20, lines 32-37; col. 16, lines 7-11: if the service can function as either the service requestor

Art Unit: 3709

or provider, then the request can be initiated by the service; as described in the specification of the current application (10/788902), this is the PUSH method (page 17, lines 26-28). The applicant admits that this method is prior art (page 20, lines 9-11)).

Re claim 20: Gatto discloses a computer-readable medium having computer executable instructions (col. 17, lines 15-18) for performing a method for providing a game update service in a gaming network (col. 15, lines 20-30), the method comprising: publishing the availability of the game update service on the gaming network (Fig. 19; col. 13, lines 64-67); receiving a request to register with the game update service from a gaming machine (Fig. 20); and processing one or more service requests between the gaming machine and the game update service (Fig. 19; col. 15, lines 45-49; col. 15, lines 57-60; col. 16, lines 7-11; col. 18, lines 4-6).

Re claim 21: Gatto further discloses the computer-readable medium of claim 20, wherein the game update service comprises a web service (col. 15, lines 49-56).

Re claim 22: Gatto further discloses the computer-readable medium of claim 20, wherein the service request comprises a request for notification of a game content update by the gaming machine (Fig. 20; col. 5, lines 1-2; col. 14, lines 10-32).

Re claim 23: Gatto further discloses the computer-readable medium of claim 22, wherein the method further comprises: receiving a game content change (col. 17, lines

Art Unit: 3709

10-12; col. 19, lines 55-58); and issuing a notification of the game content update to the gaming machine in response to the game content change (Fig. 20; col. 5, lines 1-2; col. 14, lines 10-32).

Re claim 24: Gatto further discloses the computer-readable medium of claim 20, wherein the service request comprises a request to download game content to the gaming machine (col. 15, lines 20-30).

Re claim 25: Gatto further discloses the computer-readable medium of claim 24, wherein the service request is initiated by the gaming machine (col. 16, lines 1-3; col. 20, lines 32-37; col. 16, lines 7-11: if the gaming machine can function as either the service requestor or provider, then the request can be initiated by the gaming machine).

Re claim 26: Gatto further discloses the computer-readable medium of claim 24, wherein the service request is initiated by the game update service (col. 16, lines 1-3; col. 20, lines 32-37; col. 16, lines 7-11: if the service can function as either the service requestor or provider, then the request can be initiated by the service; as described in the specification of the current application (10/788902), this is the PUSH method (page 17, lines 26-28). The applicant admits that this method is prior art (page 20, lines 9-11)).

Re claim 27: Gatto discloses a computer-readable medium having computer executable instructions (col. 17, lines 15-18) for performing a method for updating game content on

Art Unit: 3709

a gaming machine via a game update service in a gaming network (col. 15, lines 20-30), the method comprising: issuing a request to discover a service description for the game update service (col. 15, lines 60-62); receiving the service description (col. 15, lines 63-67); registering with the game update service (Fig. 20; col. 15, lines 62-63; col. 17, lines 22-24); and processing one or more service requests between the gaming machine and the game update service (Fig. 19; col. 15, lines 45-49; col. 15, lines 57-60; col. 16, lines 7-11; col. 18, lines 4-6).

Re claim 28: Gatto further discloses the computer-readable medium of claim 27, wherein the game update service comprises a web service (col. 15, lines 49-56).

Re claim 29: Gatto further discloses the computer-readable medium of claim 27, wherein the service description comprises a web services description language (col. 15, lines 52-53).

Re claim 30: Gatto further discloses the computer-readable medium of claim 27, wherein the service request comprises a request for notification of a game content update (Fig. 20; col. 5, lines 1-2; col. 14, lines 10-32).

Re claim 31: Gatto further discloses the computer-readable medium of claim 30, wherein the method further comprises: receiving a notification that game content has

Art Unit: 3709

been updated (Fig. 20; col. 5, lines 1-2; col. 14, lines 10-32); and issuing a request to download the game content (col. 15, lines 20-30).

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 13-17 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 13-17 of copending Application No. 10/788,661 in view of Gatto (US 6,916,247). Both sets of claims are similar except for the service. According to Gatto (col. 15, lines 54-56), any type of web services can be offered. Therefore, substituting gaming management service for a game update service is obvious.

This is a provisional obviousness-type double patenting rejection.

11. Claims 1-11, 13-17, and 20-30 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1, 2, 5, 6, 8-10, 13-16, 20-24, 28, 29, 32, 33, 35-37, and 40-43 of copending Application No. 10/789,957 in view of Gatto (US 6,916,247). Both sets of claims are similar except for the service. According to Gatto (col. 15, lines 54-56), any type of web services can be offered. Therefore, substituting progressive service for a game update service is obvious.

This is a provisional obviousness-type double patenting rejection.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Burbeck discloses content tracking in transient communities. Wesley discloses providing management functions in decentralized networks. Barnes discloses system, method, and computer program product for providing location based services and mobile e-commerce. Maes discloses universal IP-based and scalable architectures across conversational applications using web services for speech and audio processing resources. Vasudevan discloses web services. Prescod discloses second generation web services. UDDI.org discloses FAQs regarding UDDI.

Art Unit: 3709

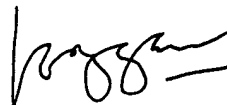
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Leung whose telephone number is 571-270-1342. The examiner can normally be reached on Mon -Thur, every other Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jong-Suk (James) Lee can be reached on 571-272-7044. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jennifer Leung
November 7, 2006



KIM NGUYEN
PRIMARY EXAMINER